REMARKS

In the Office Action[1], the Examiner:

rejected claims 9-16[2] under 35 U.S.C. § 112, second paragraph, as allegedly indefinite;

rejected claims 1-5, 9-13, and 17-21 under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent Publication 2002/0059127 to Brown et al. ("Brown") in view of U.S. Patent No. 7,016,870 to Jones et al. ("Jones");

rejected claims 7, 8, 15, 16, and 23-25 under 35 U.S.C. § 103(a) as allegedly obvious over Brown and Jones in view of U.S. Patent Publication 2005/0262014 to Fickes ("Fickes");

rejected claim 27 under 35 U.S.C. § 103(a) as allegedly obvious over Brown, Jones, and Fickes in view of U.S. Patent Publication 2004/0158479 to Adhikari ("Adhikari"); and

rejected claim 28 under 35 U.S.C. § 103(a) as allegedly obvious over Brown, Jones, Fickes and Adhikari, in view of Official Notice.

Claims 1-5, 7-13, 15-21, 23-25, 27, and 28 are pending in this application. Claims 1, 9, 17, and 25 are amended by this reply. No new matter is added by this Amendment.

In the Office Action, the Examiner found that Applicant had not adequately traversed the reliance on Official Notice. For the reasons set forth below, Applicant respectfully disputes this finding.

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[1] The Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

[2] Claim 14 is cancelled. Applicant assumes that the inclusion of claim 14 in the rejection was a typographical error.

Applicant respectfully traverses the rejection of claims 9-16 under 35 U.S.C. § 112, second paragraph. Without acquiescing to the propriety of the rejection, independent claim 9 has been amended to expedite prosecution of this application and overcome the rejection. Claim 14 is cancelled. Claims 10-13, 15, and 16 depend from claim 9 and are themselves definite. Accordingly, Applicant respectfully requests that the rejection of the claims under 35 U.S.C. § 112 be withdrawn.

Applicant respectfully traverses the rejections of the claims under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established with respect to these claims because the claims have been improperly construed and because the cited references do not teach or suggest each and every feature of the claims, as asserted by the Office Action.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See id. "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2154. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences

themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. §2141.02(I), internal citations omitted (emphasis in original).

"[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

Claim 1 recites, in part, "displaying advice regarding the balance sheet objects on a display, the advice being based on the manner or degree to which the conditions are satisfied." The Office Action correctly recognizes that Brown does not disclose or suggest at least this feature of claim 1. Office Action p. 9. The Office Action does allege, however, that Jones remedies the deficiencies of Brown. *Id.* But, this allegation is not correct.

Jones discloses "constraints defined by the user may also be taken into consideration by the optimization process. For example, the user may indicate a desire to have a certain percentage of his/her portfolio allocated to a particular financial product. In this example, the optimization module 340 determines the allocation among the unconstrained financial products such that the recommended portfolio as a whole

accommodates the user's constraint(s) and is optimal for the user's level of risk tolerance." Jones col. 17, lines 54-62.

The Office Action alleges that disclosure in Jones of "determin[ing] the allocation" and "recommended portfolio" are "indicative of Applicant's presenting advice," in that "[t]he advice (determining the allocation) is based on conditions (constraints defined by the user)." Office Action p. 4. This interpretation of Jones, however, is inconsistent with the recitation of the claims.

For example, in Jones, a "user" defines "constraints" on the user's portfolio based on a provided "user's risk tolerance." *See* Jones col. 17, lines 49, 54-62. Based on the "constraints," Jones "optimizes" a portfolio such that the "recommended portfolio as a whole **accommodates the user's constraint(s)** and is **optimal for the user's level of risk tolerance**." *See* Jones col. 17, lines 54-62. Thus, Jones does not disclose that the "allocation," which the Office Action incorrectly alleges as constituting "advice," is "based on the manner or degree to which" the "constraints" in Jones are satisfied. In other words, the "constraints" in Jones **must** be satisfied in order to "accommodate the user's constraints" according to the "optimal . . . user's level of risk tolerance." Therefore, there cannot be a "manner or degree" to which "conditions are satisfied" because the alleged "conditions" in Jones are **always** satisfied.

The Office Action alleges that Jones disclosure of "a desire to have a certain percentage of his/her portfolio allocated to a particular financial product" (*See* Jones col. 17, lines 37-38) is "representative of Applicant's degree to which the conditions are satisfied." Office Action p. 5. But, this allegation is not correct.

A disclosure of a "certain percentage" of a "portfolio" allocated to a "particular financial product" does not disclose or suggest a claimed "degree to which conditions are satisfied" at least because a "certain percentage" is a minimum threshold of a "constraint" that is either satisfied or not satisfied by the "allocation." The "percentage" in Jones is a "constraint" that **must** be met as part of the "allocation." Therefore, the "certain percentage" cannot reasonably be said to disclose or suggest a "manner or degree to which [a] condition [is] satisfied" because the "certain percentage" is itself a "constraint" that is either met or not met. The "certain percentage" cannot be indicative of a "manner or degree" to which a "condition" is "satisfied."

Furthermore, Jones does not disclose or suggest "advice regarding the balance sheet objects." Even if "determining the allocation" in Jones could constitute the claimed "advice," which Applicant does not concede, the "allocation" is not a "balance sheet object." An "allocation" in Jones is merely a proposal of a portfolio organization and cannot reasonably be said to constitute a "balance sheet object" at least because nothing in the proposed "allocation" could be considered as part of the claimed alleged "balance sheet."

Therefore, for at least this additional, independent reason, a *prima facie* case has not been made with respect to claim 1. Jones does not remedy the deficiencies of Brown, as described above. Applicant respectfully requests that the rejection be withdrawn.

Notwithstanding the above, claim 1 is allowable for at least another separate and distinct reason. Brown teaches away from Jones.

As discussed in the previous responses, there are at least two reasons why Brown and Jones are not properly combinable. First, Brown is focused on **losing** money for tax purposes, and Jones is focused on portfolio "allocation" for managing risk in a manner to **make** money. Inasmuch as Brown loses money, and Jones makes money, their purposes are contradictory. Second, Brown teaches immediately selling an asset immediately when a "tax loss threshold" is reached. *See* Brown paragraph [0014]. Since the assets are sold immediately, and to lose money, there can be no reason to include an optimal "portfolio allocation" of Jones into the valuation of Brown in order to make money. Indeed, delay in performing the "portfolio allocation" could frustrate the purpose of Brown and prevent Brown from maximizing losses, according to its stated purpose.

The Office Action states that "[t]he allegation that Brown makes no provision for the "manner or degree to which one or more of the presettable conditions are satisfied" as claimed in claim 1 . . . is irrelevant in that Jones is cited for teaching this limitation." Office Action p. 6. Applicant respectfully suggests that the Examiner may have misconstrued Applicant's remarks.

Applicant recognizes that Jones is relied upon in the Office Action as allegedly disclosing a "manner or degree to which one or more of the presettable conditions are satisfied," which as discussed above, is incorrect. Notwithstanding, however, the argument that Brown cannot take into account a "manner or degree to which one or more of the presettable conditions are satisfied" is indicative of the impropriety of combining Brown and Jones. As discussed above, incorporating the alleged "manner or

degree" from Jones into Brown defeats the purpose of Brown (the automatic sale of assets when a threshold is reached). The "threshold" in Brown is either met or not met. There is no "manner or degree" to which the "threshold" of Brown can be met. Therefore, it is not irrelevant that Brown cannot determine a "manner or degree to which a presettable condition is satisfied" at least because it is yet another reason why Brown teaches away from Jones. The incorporation of a "manner or degree to which the presettable conditions are satisfied," which Jones does not even disclose, would render Brown inoperable for its intended purpose; losing as much money as possible for tax purposes. Therefore, Brown teaches away from Jones.

For at least this reason, a *prima facie* case has not been made with respect to claim 1 at least because Brown teaches away from Jones. Applicant respectfully requests that the rejection be withdrawn.

Independent claims 9, 17, and 25 contain features similar to those discussed in connection with claim 1. None of Fickes, Adhikari, or Official Notice remedy any of the deficiencies of Brown and Jones as outlined above. Applicant therefore asserts that these claims are allowable for at least similar reasons as claim 1. The dependent claims are allowable for at least the same reasons as the independent claims from which these dependent claims depend. Applicant respectfully requests the Examiner withdraw the rejections of the claims under 35 U.S.C. § 103 and allow the claims.

With particular respect to the rejection of claim 28 under 35 U.S.C. § 103(a) over Jones, Fickes, Adhikari, and Official Notice, Applicant notes that dependent claim 28

depends indirectly from independent claim 25 and is allowable at least due to its dependence. The reliance on at least Official Notice remains improper.

In the reply filed on December 18, 2009, Applicant traversed the reliance on Official Notice in the Office Action by requesting evidence that support the assertions of the Office Actions which constitutes a proper traversal. *See* Amendment, filed December 18, 2009, p. 22. Official Notice was and is improper at least because no evidence has been provided that demonstrates a *prima facie* case of obviousness.

In reply, the Office Action cited M.P.E.P. § 2144.03 C which states "[t]o adequately traverse . . . a finding [of Official Notice], an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art." It continues citing to *In Re Chevenard*, 60 U.S.P.Q at 241, which states "[i]n **the absence of any demand by appellant for the examiner to produce authority for his statement**, we will not consider this contention." Here, Applicant **did** request that the Examiner produce authority for the reliance on Official Notice, a proper traversal of the reliance on Official Notice. The M.P.E.P. continues to state "[t]he Board [or examiner] must point to some concrete evidence in the record to support these findings to satisfy the substantial evidence test." M.P.E.P. § 2144.03 C citing *In Re Zurko*, 258 F.3d 1386 (internal quotes omitted). No evidence exists in the record to support the reliance on Official Notice.

The Office Action states that displaying "a difference between the amortized acquisition value and an impairment value of the object when displaying a calculated

impairment price" is now "applicant's admitted prior art." Office Action p. 7. Applicant does not concede to this finding. Applicant properly traversed the reliance on Official Notice in the previous rejection and no evidence to support the reliance on Official Notice in the Office Action has been provided. Therefore, the rejection of claim 28 remains improper, and should be withdrawn. Applicant renews the request that to the extent the Office Action relies on Official notice, it also provide documentary evidence of each and every assertion made in the Office Action.

CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: June 3, 2010

By: _____
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